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UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

BARNES & THORNBURG LLP
P.O. BOX 2786
CHICAGO, IL 60690-2786

In re Application of AMOS
U.S. Application No.: 10/527,308
PCT Application No.: PCT/GB03/02437
Int. Filing Date: 04 June 2003
Priority Date Claimed: 11 September 2002
Attorney Docket No.: 920602-98865
For: SPECTRAL DISCRIMINATION
APPARATUS AND METHOD

DECISION

This is in response to applicant's "Response to Communication Dated November 22, 2007 and Further Petition Pursuant to 37 C.F.R. §1.497(d)" filed 22 February 2008.

BACKGROUND

On 04 June 2003, applicant filed international application PCT/GB03/02437, which claimed priority of an earlier United Kingdom application filed 11 September 2002. A copy of the international application was communicated to the USPTO from the International Bureau on 25 March 2004. The thirty-month period for paying the basic national fee in the United States expired on 11 March 2005.

On 09 March 2005, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 25 November 2005, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 29 March 2006, applicant filed a petition under 37 CFR 1.47(a).

On 30 May 2006, this Office mailed a decision dismissing the 29 March 2006 petition as moot on grounds that the purportedly non-signing inventor is not listed as an inventor in the international application.

On 10 July 2006, applicant filed a petition under 37 CFR 1.497(d).

On 21 August 2006, applicant filed a supplement to the petition filed 10 July 2006.

On 22 November 2007, this Office mailed a decision dismissing the 10 July 2006 petition.

On 22 February 2008, applicant filed the present renewed petition under 37 CFR 1.497(d).

DISCUSSION

37 CFR 1.497(d) states,

If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application, or if a change to the inventive entity has been effected under PCT Rule 92bis subsequent to the execution of any oath or declaration which was filed in the application under PCT Rule 4.17(iv) or this section and the inventive entity thus changed is different from the inventive entity identified in any such oath or declaration, applicant must submit:

- (1) A statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part;
- (2) The processing fee set forth in § 1.17(i); and
- (3) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b) of this chapter); and
- (4) Any new oath or declaration required by paragraph (f) of this section.

Petitioner has previously satisfied items (2) and (4) above.

With regard to item (1) above, the requisite statement has been provided.

With regard to item (3) above, although the renewed petition establishes that the assignee Medical Research Council has ownership of the present application, written consent to the change of inventorship has not been provided.

CONCLUSION

For the reasons above, the renewed petition under 37 CFR 1.497(d) is DISMISSED without prejudice.

If reconsideration on the merits of this decision is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file a proper

response will result in ABANDONMENT of the present application. Extensions of time under 37 CFR 1.136(a) are available.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Bryan Lin
PCT Legal Examiner
PCT Legal Office

Telephone: 571-272-3303
Facsimile: 571-273-0459